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I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date below:

August 11, 2003

Date

Mark B. Wilson

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Hansgeorg Schindler

Serial No.: 09/845,006

Filed: April 27, 2001

For: ARRANGEMENT FOR VISUALIZING  
MOLECULES

Group Art Unit: 1639

Examiner: Jon D. Epperson

Atty. Dkt. No.: SONN:010US

**RESPONSE TO RESTRICTION REQUIREMENT DATED JULY 11, 2003**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Commissioner:

This paper is submitted in response to the Restriction Requirement dated July 11, 2003 for which the date for response is August 11, 2003.

It is believed that no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/SONN:010US.

In response to the restriction requirement which the Examiner imposed, Applicant provisionally elects to prosecute claims 24-44, the Group I claims, but solicits prosecution of all claims in the same case for the reasons set forth below.

In the Restriction Requirement, the Examiner stated the inventions are distinct due to ~~Group I and II being related as product and process of use. The Examiner further states that the~~ process of using the product as claimed could be practiced with another materially different product, for example, the molecule could be monitored with different physical methods *e.g.*, X-ray, NMR, mass-spec, electrochemical, *etc.* The Examiner also states that there would be an undue search burden given that the different methods and products would require completely different searches in the patent and non-patent database.

Applicant without prejudice suggests that the arrangement as claimed specifically recites the use of single dye tracing (SDT) to monitor the molecule. Therefore, the Examiner's statement that different physical methods *e.g.*, X-ray, NMR, mass-spec, electrochemical, *etc.* could be used to monitor the molecule is not valid. Furthermore, the Applicant points out that the Examiner would not have a serious burden of conducting a patentability search since the claimed arrangement and the claimed tracing methods both relate to SDT and are not distinct inventions.

This response is without prejudice or disclaimer in that, if, despite the above, the Restriction is determined to be proper, because Group I and Group II claims are not limited to an apparatus only for use in SDT, Applicant does not dispute that scope of the Group I claims and understands that the claims are not so limited.

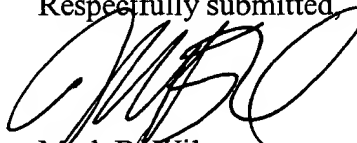
In response to the species election requirement, as the Group I claims are provisionally elected, the Applicant elects the following distinct subgroup species for initial examination. For subgroup 1, the marker molecule elected is -- DMPE-Cy5, with claims 24-45 being generic to this species. For subgroup 2, the light source elected is -- dye laser, with claims 24-45 being generic for this species. For subgroup 3, the detection and analysis system elected is --

epifluorescence microscope which has a galvano-optical mirror in the parallel beam region, with ~~claims 24-44 being generic to this species. For subgroup 4, the sample elected is -- the cell itself,~~ with claims 24-45 being generic to this species. For subgroup 5, the sample holding means elected is -- a normal sample holding means of an epifluorescence microscope, with claims 24-42, 44, and 45 being generic to this species. For subgroup 6, the control unit elected is -- processor controlled xy drive and software, with claims 24-45 being generic to this species. For subgroup 7, the plate elected is -- microtiter, with claims 24-45 being generic to this species.

In the event that Applicant's arguments above are availing, and the Examiner determines it is appropriate to examine Group I and Group II inventions in the instant case, Applicant elects the same subgroup species for the Group II claim as for Group I claims, with all of claims 46-60 being generic as to each of these species.

The Examiner is invited to contact the undersigned attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted



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Date: August 11, 2003



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August 11, 2003 Date	 Mark B. Wilson

Re: SN 09/845,006 "ARRANGEMENT FOR VISUALIZING MOLECULES" -  
Hansgeorg Schindler  
Client Ref. R 37833/R  
Our Ref. SONN:010US

Commissioner:

- (1) A Response to Restriction Requirement dated July 11, 2003; and
- (2) A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/SONN:010US.

Respectfully submitted,

Mark B. Wilson

Reg. No. 37,259

MW:SF  
Enclosures

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